

REMARKS

The application has been amended and is believed to be in condition for allowance.

Claims 27-28 are new and depend from claim 19. These claims recite a method of using the device of claim 19. No new matter is entered by the present amendments.

Allowed Subject Matter

Claims 1 and 3-8 have been allowed.

Claim Rejections - 35 USC § 112

Claims 19-21 and 23-25 were rejected under section 112, 2nd paragraph as indefinite.

The claims have been amended to remedy the stated basis of rejection. However, as to the limitation of "the rod plate" in the tenth and eleventh lines of claim 25, see in claim 25 the earlier recitation of "the attachment part comprises a rod plate," which provide the necessary antecedent basis.

Withdrawal of the rejection is solicited.

Claim Rejections - 35 USC § 102

Claims 19, 22-23 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (U.S. Patent 6,290,704).

The recitation of the "tibial plate" in the rejected claims has been amended to means for providing support on an upper surface of the cut tibia. This recitation is in section 112, 6th "means for..." format and corresponds to the tibia plate 2 disclosed in the specification. No new matter is entered by this amendment.

Section 112, 6th paragraph claim recitations are construed to cover the corresponding structure described in the specification and the equivalents thereof.

Burkinshaw makes no such disclosure.

Burkinshaw is neither a device for positioning a total knee prosthesis (claim 19) nor a device for displacing a tibia and a femur, the tibia having a cut proximal surface (claim 23).

The functional recitations of the present claims, recited in section 112, 6th format, are properly directed to the structure of the invention, and therefore must be given due consideration to cover the corresponding structure described in the specification and the equivalents thereof.

Contrary to the position taken in the rejection, Burkinshaw does not disclose a device for positioning a total knee prosthesis nor a device for displacing a tibia and a femur, the tibia having a cut proximal surface.

According to Column 1, lines 10-13; Column 2, lines 55-59; Column 2, line 63 through Column 3, line 9, Burkinshaw describes an instrument which provides distal femoral sizing for

a femoral prosthesis (not a total knee prosthesis) and which guides the cutting of the anterior and the distal femoral cuts.

The tibia is never mentioned in Burkinshaw and there is no discussion concerning using the Burkinshaw device for displacing an upper surface of the tibia with respect to the rod base.

Respectfully, element 26 (offered by the rejection as the recited tibial plate) is neither suitable as a means for providing support on an upper surface of the cut tibia nor disclosed as such.

Rather, element 26 is disclosed as a pair of paddles (Column 4, line 25) which engage posterior condyles 130 of a distal femur (see figure 7, column 5, lines 35-36). There is only discussion with respect to femoral cuts, and there is no mention of a tibial cut or displacing the femur from the tibia.

As the claimed invention is recited as a device comprising a means for providing support on an upper surface of the cut tibia and a displacement element operable to displace the supporting means (bearing on an upper surface of the tibial cut) with respect to the femur (i.e., the rod base which mounts the medullary rod).

Element 26 of Burkinshaw cannot satisfy the recitation of the means for providing support on an upper surface of the cut tibia as the lowermost surface of element 26 is not flat (planar) as must be the case for providing the recited support on the cut

tibia. Compare Burkinshaw Figure 7b to Figures 26-27 of the present application.

Therefore, neither independent claim 19 nor independent claim 23 is anticipated.

Further, Burkinshaw cannot satisfy the recitations concerning the method of using the recited device of claim 19.

Reconsideration and allowance of these claims are therefore respectfully requested.

From the foregoing, it will be apparent that applicants have fully responded to the Official Action and that the claims as presented are patentable. In view of this, applicants respectfully request reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, it is requested that the Examiner telephone the attorney for applicants at the number set forth below if the Examiner is of the opinion that further discussion of this case would be helpful.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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